

Neifeld Docket No: INVE0013-1

Application/Patent No: 09/315,822

USPTO CONFIRMATION NO: 6988

File/Issue Date: 5/21/1999

Inventor/title: Christensen/Virtual Couponing Method and Apparatus for Use with Consumer Kiosk

Examiner/ArtUnit: Janvier/3688

ENTITY STATUS: Large

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

**37 CFR 1.702 APPLICATION FOR PATENT TERM ADJUSTMENT**

**I. Statement of the Precise Relief Requested**

The patentee requests that the Director calculate an extension of patent term under 37 CFR 1.702 to 912 days for this application. The USPTO noted only 796 days in its determination of patent term adjustment under 35 USC 154(b) in its December 16, 2009 communication.

The applicant filed a 37 CFR 1.701 Application for Patent Term Extension on May 31, 2010. However, this subsequent Application for Patent Term Adjustment is necessitated by the USPTO decision dated June 28, 2010 that vacated the January 28, 2010 office action.

**II. Material Facts in Support of the Petition**

1. The Director determined a 796 day patent term adjustment, as noted on the determination of patent term adjustment mailed May 24, 2010.

**USPTO DELAY**

2. On July 7, 2003, the applicant filed a response to a non-final action.

3. November 7, 2003 is four months from the July 7, 2003 response filing date.

4. On April 20, 2004, the USPTO mailed an office action in response to the July 7, 2003 response filing.
5. The first period of USPTO delay spans November 7, 2003 until April 20, 2004. The number of days in this period is 165.
6. On January 23, 2006, the applicant filed an appeal brief.
7. May 23, 2006 is four months from the January 23, 2006 appeal brief filing date.
8. On July 28, 2006 the USPTO mailed an examiner's answer in response to the January 23, 2006 appeal brief filing.
9. The second period of USPTO delay spans May 23, 2006 until July 28, 2006. The number of days in this period is 66.
10. On January 23, 2007, the applicant filed a notice of appeal.
11. On September 28, 2009, the USPTO mailed the BPAI decision on appeal which Affirmed in Part the examiner.
12. The third period of USPTO delay spans January 23, 2007 until September 28, 2009. The number of days in this period is 920.
13. On September 28, 2009, the applicant filed a response following the BPAI decision.
14. January 28, 2010 is four months from the September 28, 2009 response filing date.
15. On May 24, 2010, the USPTO mailed a notice of allowance.
16. The fourth period of USPTO delay spans January 28, 2010 until May 24, 2010. The number of days in this period is 116.
17. There is no overlap in the time periods of the first, second, third, and fourth periods of USPTO delay. The total number of days of USPTO delay is  $165 + 66 + 920 + 116 = 1,267$ .

## **APPLICANT DELAY**

18. On July 7, 2003, the applicant filed a response after a non-final action.
19. On January 23, 2004, the applicant filed an information disclosure statement. There was no intervening action by the USPTO.

20. The first period of applicant delay spans July 7, 2003 until January 23, 2004. The number of days in this period is 200.
21. On April 20, 2004, the USPTO mailed a final rejection.
22. July 20, 2004 is three months from the April 20, 2004 final rejection mailing date.
23. On October 20, 2004, the applicant filed a request for continued examination in response to the final rejection mailed April 20, 2004.
24. The second period of applicant delay spans July 20, 2004 until October 20, 2004. The number of days in this period is 92.
25. On November 30, 2004, the USPTO mailed a non-final rejection.
26. February 30, 2005 is three months from the November 30, 2004 non-final rejection mailing date.
27. On May 2, 2005, the applicant filed a response to the non-final rejection mailed November 30, 2004.
28. The third period of applicant delay spans February 30, 2005 until May 2, 2005. The number of days in this period is 63.
29. There is no overlap in the time periods of the first, second, and third periods of applicant delay. The total number of days of USPTO delay is  $200 + 92 + 63 = 355$ .
30. The USPTO delay, less the applicant delay is  $1,267 - 355 = 912$ .

### **III. Reasons Why the Relief Requested Should be Granted**

The extension of patent term applicable under 35 USC 154 is calculated as follows:

- A. 37 CFR § 1.702 Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).
  - (a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

This increase in patent term adjustment applies to the first, second, and fourth periods of USPTO delay noted above.

B. 37 CFR § 1.702 Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(e) Delays caused by successful appellate review. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Board of Patent Appeals and Interferences and the remand is the last action by a panel of the Board of Patent Appeals and Interferences prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision by the Board of Patent Appeals and Interferences as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under § 1.703(e). A remand by a panel of the Board of Patent Appeals and Interferences shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

This increase in patent term adjustment applies to the second period of USPTO delay noted above.

C. 37 CFR § 1.704 Reduction of period of adjustment of patent term.

(b) With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

This decrease in patent term adjustment applies to the second and third periods of USPTO delay noted above.

D. § 1.704 Reduction of period of adjustment of patent term.

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply

was filed and ending on the date that the supplemental reply or other such paper was filed;

This decrease in patent term adjustment applies to the first period of USPTO delay noted above.

#### **IV. Conclusion**

The extension of patent term applicable under 37 CFR 1.702 is 912 days. The Director should grant the petition to apply 912 days of extension of patent term instead of the erroneous 796 days of patent term adjustment calculated by the USPTO under 35 USC 154(b).

#### **V. Fee under 37 CFR 1.18(e)**

On May 31, 2010, the applicant submitted an EFS credit card authorization in the amount of \$200 to cover the fee for filing an application for the patent term adjustment.

#### **VI. List of Exhibits**

Exhibit A: A copy of the USPTO web site's PAIR Transaction History tab printout for United States Patent Application Number 09/315,822 showing the dates recorded by the USPTO for filing and mailing of papers in this application.

Date 7/16/2010

Respectfully submitted,  
/BruceMargulies#64,175/

BTM

Bruce T. Margulies  
Registration No: 64,175  
Attorney of Record

Printed: July 16, 2010 (5:29pm)

Y:\Clients\Catalina\INVE\INVE0013\INVE0013-1\Drafts\PetitionForEntryOfCorrectedPTA\_Application\_INVE0013-1\_7-13-2010.wpd

## Exhibit A



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09/315,822

VIRTUAL COUPONING METHOD AND APPARATUS FOR USE WITH CONSUMER KIOSK

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Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Published Documents	Address & Attorney/Agent References	Display
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## Transaction History

## Date Transaction Description

07-08-2010	Pubs Case Remand to TC
07-05-2010	TC Return to Pubs
06-28-2010	Mail-Petition Decision - Granted
06-28-2010	Petition Decision - Granted
06-07-2010	Petition Entered
05-31-2010	Petition Entered
06-03-2010	Pubs Case Remand to TC
06-03-2010	Correspondence Address Change
06-03-2010	Email Notification
06-02-2010	Application Is Considered Ready for Issue
05-31-2010	Issue Fee Payment Verified
05-31-2010	Issue Fee Payment Received
06-01-2010	Mail-Petition Decision - Dismissed
05-28-2010	Petition Decision - Dismissed
05-07-2010	Petition Entered
05-24-2010	Electronic Review
05-24-2010	Email Notification
05-24-2010	Mail Notice of Allowance
05-20-2010	Document Verification
05-20-2010	Notice of Allowance Data Verification Completed
05-10-2010	Email Notification
05-10-2010	Change in Power of Attorney (May Include Associate POA)
05-06-2010	Correspondence Address Change
01-08-2010	Mail Non-Final Rejection
01-04-2010	Disposal Flag Change
01-04-2010	Non-Final Rejection
01-04-2010	Disposal Flag Change
09-28-2009	Amendment/Argument after BPAI Decision
07-30-2009	Mail BPAI Decision on Appeal - Affirmed in Part
07-29-2009	BPAI Decision - Examiner Affirmed in Part
07-21-2009	Mail BOA miscellaneous communication to applicant
07-21-2009	BOA miscellaneous communication to applicant
05-21-2009	Confirmation of Hearing by Appellant
05-14-2009	Notification of Appeal Hearing
01-05-2009	Docketing Notice Mailed to Appellant
01-05-2009	Assignment of Appeal Number
12-12-2008	Appeal Awaiting BPAI Docketing
12-03-2008	Mail Reply Brief Noted by Examiner
12-02-2008	Reply Brief Noted by Examiner
11-17-2008	Exam. Ans. Review Complete
11-07-2008	Mail Supplemental Examiner's Answer
11-06-2008	2nd or Subsequent Examiner's Answer to Appeal Brief
10-22-2008	Return of Undocketed appeal to the TC
10-22-2008	Exam. Ans. Review Complete
10-16-2008	Order Returning Undocketed Appeal to the Examiner
07-24-2008	Appeal Awaiting BPAI Docketing
07-14-2008	Appeal ready for BPAI review
04-18-2008	Exam. Ans. Review Complete

04-14-2008 Mail Supplemental Examiner's Answer  
04-11-2008 2nd or Subsequent Examiner's Answer to Appeal Brief  
12-03-2007 Return of Undocketed appeal to the TC  
03-14-2008 Date Forwarded to Examiner  
01-29-2008 Reply Brief Filed  
03-14-2008 Withdraw of return of appeal  
01-29-2008 Request for Oral Hearing  
03-04-2008 Case Docketed to Examiner in GAU  
12-03-2007 Return of Undocketed appeal to the TC  
12-03-2007 Exam. Ans. Review Complete  
11-29-2007 Mail Supplemental Examiner's Answer  
11-27-2007 2nd or Subsequent Examiner's Answer to Appeal Brief  
11-14-2007 Appeal Brief Review Complete  
11-14-2007 Date Forwarded to Examiner  
11-02-2007 Appeal Brief Filed  
10-15-2007 Notice -- Defective Appeal Brief  
10-10-2007 Date Forwarded to Examiner  
01-23-2007 Defective / Incomplete Appeal Brief Filed  
01-23-2007 Appeal Brief Filed  
01-23-2007 Notice of Appeal Filed  
04-17-2007 Order Returning Undocketed Appeal to the Examiner  
01-16-2007 Appeal Awaiting BPAI Docketing  
12-01-2006 Mail Reply Brief Noted by Examiner  
11-29-2006 Reply Brief Noted by Examiner  
09-28-2006 Request for Oral Hearing  
10-03-2006 Date Forwarded to Examiner  
09-28-2006 Reply Brief Filed  
02-07-2003 Corrected filing receipt  
01-28-2003 Corrected filing receipt  
07-28-2006 Mail Examiner's Answer  
07-24-2006 Examiner's Answer to Appeal Brief  
05-09-2006 Date Forwarded to Examiner  
04-26-2006 Appeal Brief Filed  
03-27-2006 Notice -- Defective Appeal Brief  
01-26-2006 Date Forwarded to Examiner  
01-23-2006 Defective / Incomplete Appeal Brief Filed  
01-23-2006 Appeal Brief Filed  
01-23-2006 Request for Extension of Time - Granted  
01-05-2006 Mail Advisory Action (PTOL - 303)  
12-30-2005 Advisory Action (PTOL-303)  
12-13-2005 Mail Advisory Action (PTOL - 303)  
12-07-2005 Advisory Action (PTOL-303)  
10-25-2005 Mail Appeals conf. Request Defective  
10-21-2005 Pre-Appeals Conference Decision - Request Defective  
09-23-2005 Request for Pre-Appeal Conference Filed  
09-23-2005 Notice of Appeal Filed  
09-28-2005 Date Forwarded to Examiner  
09-23-2005 Amendment/Argument after Notice of Appeal  
07-26-2005 Mail Final Rejection (PTOL - 326)  
07-21-2005 Final Rejection  
05-11-2005 Date Forwarded to Examiner  
05-02-2005 Response after Non-Final Action  
05-02-2005 Request for Extension of Time - Granted  
04-20-2005 Correspondence Address Change  
04-21-2005 Change in Power of Attorney (May Include Associate POA)  
11-30-2004 Mail Non-Final Rejection  
11-28-2004 Non-Final Rejection  
11-26-2004 IFW TSS Processing by Tech Center Complete  
11-23-2004 Date Forwarded to Examiner  
11-23-2004 Date Forwarded to Examiner  
10-20-2004 Request for Continued Examination (RCE)  
11-23-2004 Disposal for a RCE / CPA / R129  
10-20-2004 Request for Extension of Time - Granted

04-07-2003	Reference capture on IDS
10-20-2004	Workflow incoming amendment IFW
10-20-2004	Workflow - Request for RCE - Begin
10-15-2004	Mail Advisory Action (PTOL - 303)
10-07-2004	Advisory Action (PTOL-303)
09-29-2004	Date Forwarded to Examiner
07-20-2004	Amendment after Final Rejection
07-20-2004	Workflow incoming amendment IFW
04-20-2004	Mail Final Rejection (PTOL - 326)
04-16-2004	Final Rejection
04-16-2004	Case Docketed to Examiner in GAU
04-16-2004	Case Docketed to Examiner in GAU
01-23-2004	Electronic Information Disclosure Statement
01-23-2004	Information Disclosure Statement (IDS) Filed
08-27-2003	Information Disclosure Statement (IDS) Filed
08-27-2003	Information Disclosure Statement (IDS) Filed
11-10-2003	Date Forwarded to Examiner
07-07-2003	Response after Non-Final Action
04-07-2003	Mail Non-Final Rejection
04-03-2003	Non-Final Rejection
02-21-2003	Preliminary Amendment
01-28-2003	Date Forwarded to Examiner
08-28-2002	Continuing Prosecution Application - Continuation (ACPA)
01-28-2003	Disposal for a RCE / CPA / R129
01-17-2003	Mail-Petition to Revive Application - Granted
08-28-2002	Petition Entered
08-28-2002	Workflow - Request for CPA - Begin
08-26-2002	Correspondence Address Change
08-27-2002	Change in Power of Attorney (May Include Associate POA)
12-12-2001	Mail Abandonment for Failure to Respond to Office Action
12-11-2001	Aband. for Failure to Respond to O. A.
06-08-2001	Request for Extension of Time - Granted
06-27-2001	Mail-Petition Decision - Granted
06-26-2001	Petition Entered
06-27-2001	Change in Power of Attorney (May Include Associate POA)
06-27-2001	Correspondence Address Change
06-27-2001	Correspondence Address Change
04-09-2001	Mail Non-Final Rejection
04-06-2001	Non-Final Rejection
02-27-2001	Case Docketed to Examiner in GAU
05-15-2000	Change in Power of Attorney (May Include Associate POA)
05-15-2000	Correspondence Address Change
05-15-2000	Change in Power of Attorney (May Include Associate POA)
09-20-1999	Information Disclosure Statement (IDS) Filed
09-20-1999	Information Disclosure Statement (IDS) Filed
09-07-1999	Information Disclosure Statement (IDS) Filed
09-07-1999	Information Disclosure Statement (IDS) Filed
11-14-1999	Case Docketed to Examiner in GAU
08-20-1999	Application Dispatched from OIPE
08-19-1999	Application Is Now Complete
06-15-1999	Notice Mailed--Application Incomplete--Filing Date Assigned
06-08-1999	IFW Scan & PACR Auto Security Review
05-27-1999	Initial Exam Team nn

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